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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,229	09/21/2000	Hulikunta Prahlad Raghunandan	JP920000221US1	9223

7590 01/22/2004

Anthony England
1717 West Sixth Street
Austin, TX 78703

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 01/22/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/666,229

Applicant(s)

RAGHUNANDAN, HULIKUNTA
PRAHLAD

Examin r

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this c mmunication appears n the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for defining searching parameters; means for grouping and prioritizing in Regarding claim 1; means for simultaneously displaying a screenful of e-mails, in claim 10; graphic sorting means, in claim 7; graphic sorting method, in claim 26; means for replying, in claim 11; search window means in claim 10, and other means plus function languages in those claims, e.g., claims 1-57, which have not been directly mentioned by the examiner, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The specification is objected to under 35 U.S.C. 112, first paragraph, as failing to adequately teach, in such clear and concise manner to enable an ordinary skill in the art to pertain, make and use to invention without undue experimentations, i.e., failing to disclose graphic sorting method, graphic sorting means, search window means.

Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose

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the necessary apparatus to perform the regarding claimed method. See In re Gunn, 190 USPQ 402, 406 (CCPA 1976.) In fact applicant's disclosure did not even include how the graphic is sorted to comprehend as the graphic sorting means, method and the search window means method, without undue experimentation.

4. Regarding claims 7, 10, 26, 29, 45 and 48 are rejected under 35 U.S.C. 112, first paragraph, for reason set forth in the objection to the specification.

It is suggested that applicant could overcome 112/first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Regarding claims 1-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly the subject matter which applicant regards as the invention.

7. The terms "or"; "and/or" in claims 1, 3, 8, 10, 12, 16, 20, 22, 27, 29, 31, 35, 39, 41, 46, 48, 50 and 54, are relative term, which render the claim indefinite, because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

8. The phrase "as many images as possible" in claims 9, 28 and 47 are a relative phrase, which renders the claim indefinite. The phrase "as many images as possible" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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9. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2, 21 and 40 recites the broad recitation “possible value”, and the claim also recites icon/symbol/letter/color which is the narrower statement of the range/limitation.

10. Regarding claims 2, 21 and 40, recite “icon/symbol/ letter/color” in the claims, such limitation renders the claims indefinite; because it is not clear whether all or any of icon, symbol, letter or color is required. For the purpose of examination, it is interpreted, as any single element in the group would satisfy the limitation.

11. The applicant is reminded that, it is an applicant duty to present the claims language in such clear, concise manner and particular point out to enable one ordinary skill in the art to make and used, without undue experimentation.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Regarding claims 1-4, 7-8, 20-22, 26-27, 39-42 and 45-46 are rejected under 35

U.S.C. 102(b) as being anticipated by Ueda et al (U.S. 5,761,644).

14. Regarding claims 1, 20 and 39, Ueda discloses a computing system consisting of a processor, associated memory, storage and input and output devices, and an email system characterized in that the said email system includes:

- a means for the user to define search parameters and possible values for each parameter with corresponding graphical images, for identifying and/or prioritizing received email messages (Col. 19, lines 20-39; Col. 20, lines 17-21),
- a means for parsing the contents of the email header and body contents and displaying the parameter values of the said messages in graphical form using the said graphical images (the classified result is displayed, infer inherency of means and step of parsing, because it is required for discerning the e-mails header content or etc. Col.20, lines 30-35),
- a means for grouping, and prioritizing the said graphical message displays in accordance with user-defined requirements (classifying e-mails by highest similarity or priority Col.19, line 40-Col.20, line 26), and
- a means for accessing any message selected from the said graphical display (Mail, retrieval buttons, Fig. 47).

15. Regarding claims 2, 21 and 40, Ueda discloses means for defining search parameters includes a parameter definition table containing parameter name, and corresponding letter (Col. 19, lines 20-39; classify mode by content, e.g., letter, Fig. 50).

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16. Regarding claims 3, 22 and 41, Ueda discloses parameters include sender, subject and specific content keyword (Fig. 50, Col. 19, lines 20-39).

17. Regarding claims 4 and 42, Ueda discloses means for defining parameters values and corresponding graphical images includes buttons and icons in the graphical user interface that can be selected using a pointing device (Fig. 52A-C).

18. Regarding claims 7, 26 and 45, Ueda discloses means for grouping and prioritizing the graphical display is a graphical sorting means (Fig. 52).

19. Regarding claims 8, 27 and 46, Ueda discloses means for accessing any message is the keyboard or pointing device (Mail, retrieval buttons, Fig. 47).

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Regarding claims 5, 6, 9-19, 23-25, 28-38, 43-44 and 47-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al (U.S. 5,761,644).

22. Regarding claims 5, 24 and 43, Ueda discloses the invention substantially, as claimed, as described in their base claims, including a capability of arranging buttons in row and column format (Fig.52). Ueda does not explicitly disclose using specific number of rows and columns as claimed. However arranging objects or buttons in a specific row and column, such as 3 rows, 1 column as taught in Ueda or 14 rows and 17 columns as claimed, would have been obvious to

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one ordinary skill in the art that was a matter of application design choice, which produced no new and unexpected result, in which the court held unpatentable [See MPEP 2144.04 (V)(C), (VI)(B)].

23. Regarding claim 23, Ueda discloses the invention substantially, as claimed, as described in claim 29, including means for defining parameters values and corresponding graphical images includes buttons and icons in the graphical user interface that can be selected using a pointing device (Fig. 52A-C).

24. Regarding claims 6, 14, 25, 33, 44 and 52, Ueda discloses the invention substantially, as claimed, as described in their base claims, but failed to include using a standard text parsing means. However, the claims language itself admitted the text parsing means is standard and conventional. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modified Ueda's teaching by including a standard text parsing means, with the motivation of simplifying system design and utility.

25. Regarding claims 9, 28 and 47, Ueda discloses the invention substantially, as claimed, as described in their base claims, but failed to include means for increasing and reducing the size of the graphical display images. Official Notice is taken (see MPEP 2144.03) that adjusting icons size was well known in the art. It has been widely utilized in a conventional Windows O/S and conventional browser, e.g., Internet explorer, Netscape, which allowed user to change size of icon in order to fit more icons on the their button bars of screen. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modifying size of icon or graphic image in Ueda with the well-known' teaching, in order to fit more graphic image on the screen.

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26. Regarding claims 10, 29 and 48, Ueda discloses the invention substantially, as claimed, as described in their base claims, but failed to include means for simultaneously displaying a screenful of e-mails content, in separate scrollable frames, by mouse selection of e-mail button. Official Notice is taken (see MPEP 2144.03) that simultaneously displaying mail in separate window was well known in the art. An exemplary system that capable of displaying e-mails content on the top portion of screen, while displaying more specific content of the e-mail on the bottom portion of separate scrollable screen. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modified Ueda's teaching by expanding simultaneous displaying as suggested by conventional e-mail software such as Microsoft Outlook 97, with the motivation of making system more user friendly, simplifying utility and increasing user's convenient.

27. Regarding claims 11, 30 and 49, Ueda discloses the invention substantially, as claimed, as described in their base claims, but failed to include means for replying any e-mail in its frame while viewing e-mail contents. Official Notice is taken (see MPEP 2144.03) that mean for replying e-mail was well known in the art. Exemplary means is the Microsoft Outlook 97, which includes a reply icon in its button bar, which allows its' users to click on for replying any e-mail, group of e-mails at any time including while viewing any piece of e-mail. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the common feature such as a replying means with Ueda's teaching, with the motivation of enhancing capability and flexibility of Ueda's system, because e-mail system without replying capability would be useless.

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28. Regarding claims 12, 17, 31, 36, 50 and 55, Ueda discloses the invention substantially, as claimed, as described in their base claims, including:

- means for the user to define parameters for classifying received email messages (Fig. 50-52),

- means for classifying each email after parsing email content or header to obtain values of classification parameters (Fig. 49),

- a means for arranging and displaying said classified email messages in a hierarchical structure (Fig. 45, 52A-C),

- a means for accessing a message at the lower level of the hierarchy from said display (pointer device can point and click to access e-mail at any level).

Ueda fails to disclose sorting means. Official Notice is taken (see MPEP 2144.03) that e-mail sorting means or capability was well known in the art. Exemplary means is the Microsoft Outlook 97, which allowed users to sort e-mails in their mailbox by size, by date, priority, name individually or in combination and etc. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate sorting means or capability as suggested in the conventional e-mail program such Microsoft Outlook 97 with Ueda's teaching with the motivation of simplifying e-mail access and retrieval.

29. Regarding claims 13, 18, 32, 37, 51 and 56, Ueda discloses the invention substantially, as claimed, as described in their base claims, including all other parameters but failed to include size of the message. However, Ueda allows, its' users to define any other parameter as desired. In addition, Official Notice is taken (see MPEP 2144.03) that including message size as a parameter was well known in the art. Exemplary means is the Microsoft Outlook 97, which

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includes size of the e-mail, to help the users to decide whether to retrieve such e-mail, with or without opening it. In order to save time and bandwidth usage. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate size of message as a parameter in Ueda's system, with the motivation of enhancing decision making ability to the user.

30. Regarding claims 15, 16, 34, 35, 53 and 54, Ueda discloses means for displaying and selecting the said email messages in a hierarchical structure is by means of buttons in the graphical user interface (user select and retrieve e-mail by means of clicking on any icons, (Mail, retrieval buttons, Fig. 47, 52).

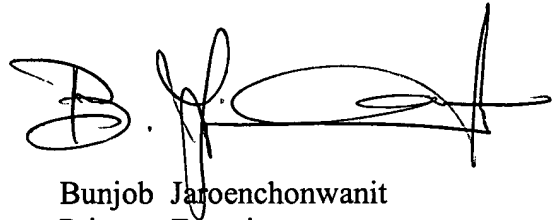
31. Regarding claims 19, 38 and 57, Ueda discloses the date classification parameter, the hierarchical sequence is defined in terms of date ranges and sub ranges (Fig. 42, e-mail display by date range and sub ranges).

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32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'B. Jaroenchonwanit', with a stylized flourish extending to the right.

Bunjob Jaroenchonwanit
Primary Examiner
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/bj
1/8/04